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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Volkmar Klein

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,964	Applicant(s) KLEIN ET AL.	
	Examiner MADELINE GONZALEZ	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12 and 14-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 14-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to applicant's amendment dated March 5, 2009

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12, 14, 15, 18-20 and 23-26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler (U.S. 3,982,520) in view of Nichtnennung (DE 3100499A1).

With respect to **claim 11**, Wheeler discloses a filter device, as shown in Fig. 1, having:

- a filter housing 26 having first and second fluid connections and an exterior surface, as shown in Fig. 3;
- a filter element held in said filter housing 26, as shown in Fig. 3;
- a fluid container 24 having an exterior surface and being located adjacent to and side-by-side with said filter housing 26 to define a lateral space therebetween; and
- a connector 20 coupling said fluid connections to said fluid container 24, said connector 20 having at least one displaceable blocking part 60 blocking said

- fluid connections in a blocking position thereof and opening said fluid connections in an open position thereof;
- said blocking part 60 being located between and accessible from said exterior surfaces of said filter housing 26 and said fluid container 24 when said filter housing 26 and said fluid container 24 are coupled by said connector 20;
 - said blocking part 60 including a sliding valve part guided for movement between and sealed between first and second connecting plates 20, 22, of said connector 20 by seals 38, 56, facing said filter housing 26 and facing said fluid container 24;
 - said connector 20 with said blocking part 60 being located in said lateral space with said filter housing 26 and said fluid container 24 being on opposite sides of said connector 20, as shown in Fig. 3.

Wheeler **lacks** the blocking part displaceable longitudinally and the specific shape of the valve, i.e., plate-shaped.

Nichtnennung teaches a filter device, as shown in Fig. 1, having a connection housing 1 coupled to a filter 6, said connection housing 1 including three plate-shaped valves 10, 11, 12, longitudinally displaceable in order to open and closed fluid passages. It would have been obvious to provide the valve disclosed by Wheeler displaceable longitudinally as taught by Nichtnennung in order to open and closed fluid passages and since the provision of a rotational and/or longitudinal movement to a valve is very common in the art (see page 5, lines 1-6 of translation of Nichtnennung document). Furthermore, it would have been obvious to one of ordinary skill in the art at

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the time the invention was made to provide a plate—shape configuration, as taught by Nichtnennung, to the valve disclosed by Wheeler, since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

With respect to **claim 12**, Wheeler discloses wherein said fluid container 24 is an internal combustion engine. The recitation “wherein said fluid container is a hydraulic tank” is considered a recitation of the intended use of the claimed invention which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the container 24 is capable of being a hydraulic tank.

With respect to **claim 14**, Wheeler discloses wherein said fluid connections include a fluid inlet and a fluid outlet in said filter housing 26; said connecting plates 20, 22, include fluid passages corresponding to and forming part of said fluid connections; and said blocking part 60 has wall parts that cover said fluid connections in the blocking position and has openings that clear said fluid connections in the open position, as shown in Figs. 3 and 4.

With respect to **claim 15**, Wheeler discloses wherein said fluid inlet and said fluid outlet are located one of top of another in a direction of a longitudinal axis of said filter housing 26, and are adjacent one another and open directly on said exterior surface of said filter housing 26; said fluid passages are located one on top of another in said direction of said longitudinal axis and are adjacent one another; and said blocking part 60 has clearance openings 64, 62, between said wall parts, said clearance openings 64, 62, being aligned and congruent with said fluid passages in the open position to convey fluid therethrough, as shown in Fig. 3.

With respect to **claim 18**, Wheeler discloses wherein said filter connections of said filter housing 26 are encompassed on an outer peripheral side thereof by an attachment part; and said connector 20 has flange parts 72, 70, on a connecting plate thereof facing said attachment part, said connecting plate having fluid passages therein encompassed by said flange parts, as shown in Fig. 3.

With respect to **claim 19**, Wheeler discloses wherein said attachment part includes a locking part received in an opening in one of said flange parts 70, and a locking part 69 received in a recess in said blocking part 60 in the open position, said locking part 69, said opening and said recess extending transversely to a movement direction of said blocking part 60, as shown in Fig. 3.

With respect to **claim 20**, Wheeler discloses wherein said locking device includes a locking pin 69, as shown in Fig. 4.

With respect to **claim 23**, Wheeler as modified by Nichtnennung discloses wherein said blocking plate moves translationally between the blocking and open positions, as shown in Fig. 1 of Nichtnennung.

With respect to **claim 24**, Nichtnennung discloses wherein said fluid connections 2 and 3 extend perpendicular to a longitudinal axis of said filter housing, as shown in Fig. 1, and it would have been obvious to modify the housing of Wheeler in this manner since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

With respect to **claim 25**, Wheeler discloses wherein said blocking part 60 has two openings 64, 62, and two wall parts, as shown in Fig. 4.

With respect to **claim 26**, Wheeler discloses wherein said two openings 64, 62, and said two wall parts are fixedly connected for simultaneous movement thereof only, as shown in Fig. 4.

Claims 16 and 17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler (U.S. 3,982,520) in view of Nichtnennung (DE 3100499A1) as applied to claim 11 above, and further in view of Gandini et al (U.S. 6,485,635) [hereinafter Gandini].

With respect to **claim 16**, Wheeler and Nichtnennung **lack** wherein said first and second fluid connections has first and second valves, respectively.

Gandini teaches a filter, as shown in Fig. 1, having a housing 10, a check valve 28 disposed on filter element 14, and a back-flow check valve 25 disposed in a support tube 11, as shown in Fig. 2, in order to prevent the filter from running empty (see col. 2, lines 4-8). It would have been obvious to provide the filter disclosed by Wheeler as modified by Nichtnennung with valves in the inlet and outlet of the housing, as taught by Gandini in order to prevent the filter from running empty (see col. 2, lines 4-8).

With respect to **claim 17**, Wheeler as modified by Nichtnennung and Gandini discloses wherein said first fluid connection includes a fluid outlet of said filter housing, with said first valve having a valve disk located on an outside of and over said fluid outlet, as shown in Fig. 2 of Gandini, and being independent of said blocking part; and said fluid connection includes a fluid inlet of said filter housing, with said second valve having a valve disk integrated within said filter inlet and being independent of said blocking part, as shown in Fig. 2 of Gandini.

Claim 21 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler (U.S. 3,982,520) in view of Nichtnennung (DE 3100499A1) as applied to claim 11 above, and further in view of Tomita et al. (U.S. 5,256,285) [hereinafter Tomita].

With respect to **claim 21**, Wheeler as modified by Nichtnennung discloses wherein said blocking part 60 includes a handle 69 for manual operation thereof; but **lacks** wherein said filter housing comprises a handle for manual operation thereof.

Tomita discloses a filter container 100, as shown in Fig. 13, having a base 101 and a cap portion 102 including handle 112 for convenience of transportation (see col. 7, line 1). It would have been obvious to provide the housing disclosed by Wheeler as modified by Nichtnennung with a handle as taught by Tomita in order to move said housing more easily (see col. 7, line 1).

Claim 22 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler (U.S. 3,982,520) in view of Nichtnennung (DE 3100499A1) as applied to claim 11 above, and further in view of Muzik et al. (U.S. 6,579,455) [hereinafter Muzik].

Claim 22 adds the further limitation of wherein said filter housing comprises cast aluminum; and said blocking part comprises one of steel and plastic.

Wheeler as modified by Nichtnennung **lacks** the specific claimed materials.

Muzik discloses a filter 10, as shown in Fig. 1, having a housing composed of elements 12, 14, 16, made of any suitable material, such as aluminum (see col. 5, lines 54-67 and col. 6, lines 1-5). Muzik teaches that aluminum is a preferred material for its

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low weight and strength (see col. 8, lines 66-67 and col. 9, lines 1-2). Muzik also discloses a valve 44, as shown in Fig. 9, which can be made of steel or plastic (see col. 9, lines 2-9). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the housing and blocking part disclosed by Wheeler as modified by Nichtnennung of aluminum and steel or plastic, respectively, as taught by Muzik, since Muzik teaches that those are suitable materials known in the art (see col. 9, lines 1-11).

Response to Arguments

Applicant's arguments with respect to claims 11, 12 and 14-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez
Patent Examiner
July 16, 2009

/Krishnan S Menon/
Primary Examiner, Art Unit 1797